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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 10/699,136   | 10/31/2003  | Tadashi Shiraishi    | F-8019                  | 3465             |
| 28107  | 7590        | 01/20/2006           | EXAMINER                |                  |
| JORDAN AND HAMBURG LLP<br>122 EAST 42ND STREET<br>SUITE 4000<br>NEW YORK, NY 10168 |             |                      | CARRILLO, BIBI SHARIDAN |                  |
|  |             |                      | ART UNIT                | PAPER NUMBER     |
|  |             |                      | 1746                    |                  |

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/699,136

Applicant(s)

SHIRAISHI, TADASHI

Examiner

Sharidan Carrillo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation of a copper coil is not supported by the specification as originally filed and therefore, constitutes new matter.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barry (42724007) in view of Sameshima (JP01-028625) and further in view of Withers Jr (4007774).

Barry teaches a method of cleaning pipes and tubes, in heat exchangers, using ice in combination with water (Abstract, col. 2, lines 60-65, col. 4, lines 25-45). Barry fails to teach the limitations of connecting the suction hose to the pipe and suction pump, connecting the ice-feeding hose to the pipe and supplying ice and water from the hopper into the pipe.

Sameshima teaches flushing a pipe using a carriage 1 with a suction pipe mounted thereon and waste water collecting tank 2 (Fig. 1, page 3). On page 5, Sameshima teaches cleaning with ice water until clean water flushes into the waste water collecting tank. Ice water enters port 12 and is suction pumped through the branch pipe and waste is collected in tank 2. On page 6, Sameshima teaches using the method for cleaning of a piping. Sameshima fails to teach cleaning heat exchangers.

It would have been obvious to a person of ordinary skill in the art to have modified the method of Barry to include using a suction hose and pump in connection with the pipe, in order to flush ice and water through the pipe, as taught by Sameshima, thereby cleaning the interior surface of the pipe of debris. In reference to the hopper, Barry et al. teach various magazines such as hoppers (Fig. 11), for storing ice particles and further transporting the pipe in the piping for cleaning. Additionally, it is conventional in the art to use hoppers for the generation and storage of ice particles (US5934566).

Barry in view of Sameshima fail to teach the limitations directed to the principle of reverse-flow. Withers Jr. teaches cleaning heat exchanger tubes by periodically reversing the fluid flow in order to remove coating deposits. It would have been obvious to a person of ordinary skill in the art to modify the method of Barry to include reverse flow, as taught by Withers, for purposes of effectively removing contaminants from the interior surface of the heat exchanger tubes. Additionally, the concept of enhanced cleaning by reverse flow is notoriously well known and conventionally practiced in the art.

Barry in view of Sameshima fails to teach a transparent portion of the ice feeding hose. However, it would have been within the level of the skilled artisan to modify the method of Barry et al. to include a transparent hose since Barry teaches the need to detect the completion of the cleaning cycle by observing whether ice flows into the waste water collecting tank at a faster velocity. It would have been within the level of the skilled artisan to adjust the ratio of ice to water in order to form an effective

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composition which would be easily flowable, yet effective for scrubbing the interior surface of the pipe. In reference to claim 5, Barry et al., (col. 3, lines 35-40) teaches that the diameter of the pig is selected to permit it to penetrate the lumen of the contaminated tube. Given the teachings of Barry et al, it would have been well within the level of the skilled artisan to modify the size of the ice cube depending upon the diameter of the heat exchange tubing being cleaned and the amount of contaminants present therein.

Barry in view of Sameshima and Withers fail to teach a copper coil pipe. However, it is well known in the art that heat exchangers are conventionally made out of copper coils (Leon et al., 4327560) and therefore, it would be within the level of the skilled artisan to clean copper coil piping since Barry teaches heat exchangers and heat exchangers are typically made of copper coil piping.

### ***Response to Arguments***

In view of applicant's arguments, the rejection has been withdrawn and a new grounds of rejection has been applied, as presented above.

Applicant argues the improper combination of Barry with Sameshima since Sameshima teaches against water jets and reverse-flow. Applicant further argues that the reference of Sameshima should be considered in its entirety. Applicant's arguments are not persuasive since Sameshima's comments are directed to pipes installed in condominiums and buildings. Additionally, Sameshima does not teach against water jets and reverse flow. Sameshima teaches that it is not advisable with respect to the particular application of flushing piping installed in condominiums and buildings.

Sameshima does not suggest that the process of water jets and reverse-flow would not work for other applications. Therefore, the teachings of Sameshima does not destroy the teachings of the primary reference.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues that using a suction to draw the ice through the pipes would change the principle operation of Barry and it is therefore improper to combine the teachings of the prior art. Applicant's arguments are unpersuasive since the suction pump further enhances the removal of deposits from the internal cavity of the piping.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharidan Carrillo whose telephone number is 571-272-1297. The examiner can normally be reached on Monday-Friday, 6:00a.m-2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharidan Carrillo  
Primary Examiner  
Art Unit 1746

bsc



SHARIDAN CARRILLO  
PRIMARY EXAMINER